

### **REMARKS**

This responds to the Office Action mailed on June 6, 2005, and the references cited therewith.

Claims 1, 7, 14, and 21 are amended; as a result, claims 1-26 are now pending in this application.

#### **Drawing and Specification Objections**

The drawings were objected to as failing to comply with 37 C.F.R. 1.84(p)(5). The specific objection was related to two reference numbers that appear in the drawings but did not appear to be referenced in the original filed specification. The correction to the problems was made by amending the original filed specification in the appropriate locations to include the reference numerals cited by the Examiner. Thus, these objections are no longer appropriate and should be withdrawn.

In fact, one correction to the specification, which the Examiner suggested, actually corrected one of the problems the Examiner noted. The specification is now correct with the amendments presented above and each reference numeral in the drawings has been properly noted in the specification. Accordingly, the drawing and specification objections have been resolved and should now be withdrawn.

#### **§103 Rejection of the Claims**

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitty et al. (U.S. 6,199,052). It is of course fundamental that in order to sustain an obviousness rejection that each and every step in the rejected claim must be taught or suggested in the cited reference or proposed combination or references.

Initially, Applicants note that the Examiner is not issuing an anticipation rejection with respect to claims 1-6; rather, it appears a single reference is being cited in combination with an Official Notice as to what the Examiner believes to be obvious in the art for purposes of rendering independent claim 1 obvious.

Mitty teaches relaying messages through an intermediary for purposes of ensuring that messages are received and cannot be repudiated by intended recipients of the email. See, Mitty

Abstract, lines 1-2 and throughout specification of Mitty. In Mitty, the messages are sent from the senders to an intermediary; processed on the intermediary; and sent from the intermediary to the recipients. *E.g.*, Mitty, FIGS. 1A and 1B; col. 6, lines 24-26 “sender 105 transmits a ‘package’ to a trusted intermediary 115 via potentially non-secure network 110, such as the Internet.” *Emphasis Added.* In Mitty, the intermediary cannot decrypt the contents of a message; rather, the intermediary decrypts an outer envelope and delivers to the recipient. A notice is received by the intermediary when the inner envelope of the message is decrypted by the recipient. The contents of the message are never seen and never processed by the intermediary in Mitty.

In fact, Mitty expressly does not want the intermediary to see or process the contents of a message for security reasons. Mitty uses and teaches an intermediary for purposes of validating for a sender that a recipient has received and opened a message’s contents. The contents of which are unknown and unavailable to the intermediary of Mitty. This is achieved via a series of interactions and confirmations or notifications.

It is clear that Applicants’ independent claim 1 can be distinguished over Mitty in a number of ways. First, the message is received directly from a sender in Applicants’ amended independent claim 1, which is not what is wanted or the case in Mitty where the message is received from an intermediary and not a sender. Second, contents of the message are provided to the remote server in Applicants’ amended independent claim 1, which again is not the case in Mitty where the intermediary never sees or process the contents. Third, the remote server validates the message for viruses or objectionable material; this is not taught or suggested in Mitty and admitted by the Examiner in the rejections below with respect to claims 7-26.

Finally, Applicants object to the Official Notice levied by the Examiner. The Examiner has not suggested how a flag and its usage would benefit the teachings of Mitty or for that matter how it would be used at all in Mitty. Mitty talks extensively about confirmations and notices but does not discuss any notices being sent from the intermediary to the recipient; rather notices are sent from intermediary to sender and from recipient to intermediary. Mitty, col. 6, lines 35-54.

The examiner appears to be attempting to interpret claim 1 in view of the actions of a sender in the Mitty reference, but with the added limitation that the message is received from a sender this can no longer be the case, since it is now clear these actions are of a recipient of a

message in amended independent claim 1. In view of this, there is no flag usage that Applicants can see that would be useful to the teachings of Mitty for a recipient.

Official Notice is not appropriate if not tied to the cited reference in such a manner to acquire Applicants' invention. The teachings of Mitty cannot be ignored when the proposed combination is made. There would be no motivation of one of ordinary skill in the art to modify Mitty with a flag, where that flag is received at a recipient from an intermediary and even if there were it is not clear exactly what the benefits or use of this would be within the context of Mitty.

Accordingly, there are numerous differences between Mitty and Applicants' amended independent claims and the Official Notice has been rebutted. Thus, the rejections with respect to Mitty of claims 1-6 should be withdrawn and these claims allowed.

Claims 7-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitty et al. and further in view of Radatti et al. (U.S. Publication No. 2002/0129237). Again, to sustain an obviousness rejection each and every element or step in the rejected claims must be taught or suggested in the proposed combination of references. Additionally, a proposed combination is not permissible for purposes of rendering rejected claims obvious if the proposed combination runs contrary to the teachings of the references that comprise the proposed combination.

With respect to Applicants' amended independent claims 7, 14, and 21; each of these claims now includes limitations where the message is received at a recipient from a sender. Accordingly, the rationale presented above with respect to amended independent claim 1 applies equally here and is incorporated by reference herein.

Also, the rationale and objection with respect to the Official Notice is reincorporated herein by reference, since it is entirely unclear to Applicants how and why such a communication would be used or why one of ordinary skill in the art would be motivated for such a communication in view of the teachings of Mitty.

Lastly, the teachings of Mitty are to knowingly transmit a message to a trusted intermediary for purposes of having its receipt to a recipient validated when the message is opened or decrypted on the recipient. Mitty, intentionally and alleges beneficially that contents of messages are not known or available to the intermediary, this provides what Mitty believes to

be novel security. Conversely, Radatti hides itself from message passing participants and intercepts contents and scans them. This proxy technique in Radatti may be viewed as a transparent proxy action, while the action of Mitty may be viewed as a forward proxy (one in which the participants directly go between the proxy and are configured to directly interact with one another through the forward proxy). The two techniques are not complimentary to one another they are in fact the opposite of one another. If Mitty included Radatti, then it would lose its teachings on content secrecy and would lose its forward proxy behavior between senders and recipients. Conversely, if Radatti were modified with Mitty it would lose its ability to inspect message contents and would lose its transparent proxy behavior. Thus, Applicants assert that the teachings of Radatti and Mitty are not proper, because to do so would run contrary to the individual teachings of these references.

Accordingly, the proposed combination lacks each and every limitation of Applicants' amended independent claims 7, 14, and 21 and the proposed combination cannot be properly made in view of the teachings of Mitty and Radatti. Therefore, Applicants respectfully request that the rejections of claims 7-26 be withdrawn and the claims allowed.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (513) 942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

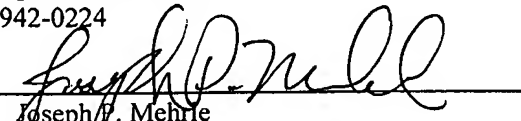
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Date 9-6-05

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 6 day of September, 2005.

Peter Rebuffoni

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